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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,587	04/20/2001	Robert Sage Blackman	20313-011	1413
24341	7590	11/15/2005	EXAMINER	
MORGAN, LEWIS & BOCKIUS, LLP. 2 PALO ALTO SQUARE 3000 EL CAMINO REAL PALO ALTO, CA 94306			VEILLARD, JACQUES	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/839,587

Applicant(s)

BLACKMAN ET AL.

Examiner

Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the Applicant's communication filed on 10/5/2005.
2. Claims 1-42 are pending and presented for examination.
3. The finality of the rejection of the last Office action is withdrawn, as per the substance of the Interview Summary mailed to the Applicant on September 12, 2005. A Non-final rejection in view of Hill et al. (U. S. Pat. No. 5,465,206) is, therefore, given.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5, 8, 9, 12, 13, 18, 24-26, 29, 31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilt et al. (U. S. Pat. No. 5,465,206).

As per claim 1, Hilt et al. disclose a computer implemented method conducted over computer network (See Hill et al. Fig.4). Similarly, a request (a bill) by a first party (a Biller B) has been formulated for an agreement (an agreement to pay a bill) is sent to a second party (consumer) (See Hilt et al. Fig.4 component 12). Both the first and second parties use client terminals to send data. The process is described at col.13, line 41 of Hilt et al. The request containing an agreement ID (the "BRN" or biller reference number) that uniquely identifies the request and any agreement formed therefrom. This request is sent over the computer network

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(102) (See Hilt et al. Fig.4 component 102) to the second party (consumer). The second party then returns correspondence (a bill pay order 122) to the first party (the biller) over the same network (102). The order is processed and saved on the biller's ledger (42) (See Hilt et al. Fig.4, component 14 in conjunction with element 42).

As per claim 36, the claim has substantially the same limitations as claim 1. These limitations have already been discussed in the rejection of claim 1. In addition, Hilt et al. disclose, the claimed limitations of: linking the second agreement to the first agreement by including the first agreement ID in the field identifying a downstream agreement to form a supply chain among the first, second and third parties (See Hilt et al. Figs. 1-3, 7, 11 and col.4, lines 7-23; col.17, lines 46-67; col.20, lines 36-67). Therefore, it is rejected on similar grounds corresponding to the argument given for the rejected claim 1 above.

As per claims 2 and 24, Hilt et al. disclose a computer implemented method conducted over the computer network. The first client computer system (the client computer of Biller B) has an independent database (ledger 42) that stores the requests (bills) submitting by Biller B and the correspondence (payment) made via the bill pay orders (See Hilt et al. Fig.4; col.12, line 41 through col.13, line17).

As per claims 3, 12, 25 and 31, the claims recite five alternatives, only one of which is limiting the claims. Hilt et al. disclose an acceptance in the form of the bill pay order (See Hilt et al. Figs.4, 6, 7 and 8 component 122).

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As per claims 4, 9, 13 and 18, Hilt et al. disclose the method wherein the bill pay order is in an electronic mail message which is encapsulated to include the agreement ID "BRN"(See Hilt et al. col.13, lines 50-53)

As per claims 5, 8, 26, 29, Hilt et al. disclose the method wherein the bill pay order is in an electronic message is a correspondence from the second party which includes a main body of information and an attachment to the main body; and wherein the attachment is according to the agreement ID on how to proceed with the transactions (See Hilt et al. col.11, lines 9-46; col.13, lines 17-41; col.14, lines 19-49).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 7, 10, 11, 14-17, 19-23, 27, 28, 30, 32-35, 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilt et al. (U. S. Pat No. 5,465,206) in view of Shirley et al. (U. S. Pat. No. 5,692,206).

As per claims 6 and 27, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above.

It is noted, however, Hilt et al. do not specifically disclose the claimed limitations of wherein the correspondence from the second party includes information unrelated to the

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formation or modification of the agreement, yet still related to the agreement as recited in claims 6 and 27. On the other hand, Shirley et al. disclose a method and apparatus for automating the generation of a legal document by providing a contract generation system that automates the generation of various legal documents, related to a negotiated agreement (See Shirley et al. Title and Abstract) including the features wherein the correspondence from the second party includes information unrelated to the formation or modification of the agreement, yet still related to the agreement (See Shirley et al. Fig. 11B components 862, 868, 874 and corresponding text).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the electronic bill pay system of Hilt et al. with the automated method for generating legal document as taught by Shirley et al. The motivation being to have enhanced the system of Hilt et al. by allowing it to advise consumer wherein a legal advisor providing corporate supplied information related to a transaction agreement and guidance to individual negotiators by assisting them in reaching and documenting an agreement with an opposing party without modifying an agreement.

As per claims 7, 16, 22, 28, and 34, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations of wherein the correspondence from the second party is taken from the group consisting of: a facsimile transmission, an electronic mail message, a letter sent by post, or an HTML document”(See Shirley et al. Fig.1B component 124, col.4, line 65 and Fig.8 component 722 and col.12, lines 3-18).

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As per claims 10, 14, 17, 23, 30, 32, and 35, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations of sending correspondence from the first party to the second party relating to the request or any agreement derived therefrom (See Shirley et al. Fig.1B component 124, col.4, line 65 and Fig.8 component 722 and col.12, lines 3-18); and “saving the correspondence from the first party relating to the request according to the unique agreement ID given the request” (See Shirley et al. abstract, Fig.7 component 660 and col.9, lines 27-30).

As per claims 11, 19, and 20, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations wherein the step of saving the correspondence from the first party relating to the request includes storing the first party correspondence in the agreement database of the first party in a record that includes or is linked to the agreement ID (See Shirley et al. Abstract, Fig.12C component 936. and col.19, lines 4-18).

As per claims 15, 21, and 33, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations wherein the correspondence from the first party includes information unrelated to the formation or modification of the agreement, yet still related to the agreement (See Shirley et al. Fig.7, and col.4, lines 40-58).

As per claims 37 and 39, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations wherein the step of linking includes: specifying the first deliverable in the second request based on the deliverables of a list of customers” (See Shirley et

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al. col.10, lines 48-62 and col.17, lines 1-17), each having a deliverable due from the second party (See Shirley et al. Abstract, col.3, line 56 through col.4, line 24); and obtaining the first agreement ID based on the deliverable specified (See Shirley et al. col.10, lines 7-16).

As per claims 38 and 40, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations of wherein the step of formulating the second request includes specifying a second deliverable and a date and time for the second deliverable (See Shirley et al. col.2, lines 14-18, col.10, lines 10-12 and lines 52-62); and specifying the first deliverable in the second request based on the deliverables of a list of customers” (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17), each having a deliverable due from the second party with a due date and time subsequent to the date and time of the second deliverable” (See Shirley et al. col.2, lines 14-18, col.10, lines 10-12 and lines 52-62); and obtaining the first agreement ID based on the deliverable specified (See Shirley et al. See Shirley et al. col.10, lines 7-16).

As per claims 41 and 42, the combination of Hilt et al. and Shirley et al., as combined, discloses the claimed limitations of wherein the step of formulating the second request includes specifying a folder and a second deliverable (See Shirley et al. Fig.1B component 200, Fig.5 component 200, Fig.8, Fig.9, col.6, lines 30-41, line 56 through col.7, lines 13, and col.12, line 28 through col.13, line 8); and specifying the first deliverable in the second request based on the deliverables of a list of customers included in the specified folder (See Shirley et al. col.10, lines 48-62 and col.17, lines 1-17); and “obtaining the first agreement ID based on the deliverable specified” (See Shirley et al. col.10, lines 7-16).



***Other Prior Art Made Of Record***

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

***Conclusion***

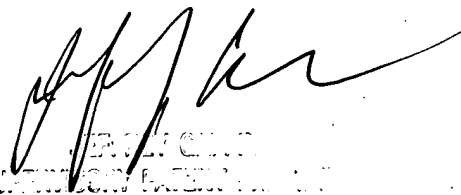
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JACQUES VEILLARD  
PATENT EXAMINER

*J.V*

Jacques Veillard  
Patent Examiner TC 2100

October 31, 2005